

PENDERGAST et al
Appl. No. 10/734,582
February 16, 2007

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REMARKS/ARGUMENTS

Reconsideration of this application and entry of the foregoing amendments are respectfully requested.

New claims 16-22 have been added. The new claims find support throughout the application including in the claims as originally filed. Particular attention is directed to page 14, line 4 (claim 16); page 14, lines 8-12 (claim 17); page 29, line 1 to page 30, line 14 (claim 19); and page 27, line 30 to page 28, line 30 (claim 20). The claims as presented are fully supported by an enabling disclosure.

The abstract has been revised so as to be more reflective of the invention, as requested by the Examiner.

Claims 7-15 stand rejected under 35 USC 112, first paragraph, as allegedly being non-enabled. Withdrawal of the rejection is submitted to be in order for the reasons that follow.

The Examiner contends that the terms "a pathogen" and "an inhibitor of Abl tyrosine kinase" render the claims non-enabled. Comments offered by the Examiner in support of the rejection consist of eight unsupported assertions. It is now well settled that a patent applicant enjoys the presumption that an invention can be practice as claimed. The burden is on the Examiner to provide evidence to the contrary. The eight broad statements bridging pages 2 and 3 of the Action do not constitute such evidence.

The studies provided in the instant application reveal a new role for Abl tyrosine kinase in pathogen infection. They demonstrate a requirement for Abl tyrosine kinase in the cellular uptake of a pathogen. While the invention is specifically exemplified using *Shigella* as the pathogen and the STI571 (Gleevec) (an FDA approved drug currently in use in treating chronic myeloid leukemia) as the Abl kinase inhibitor, Applicants teach in the application that the

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invention is applicable to other pathogens using other Abl kinase inhibitors. The Examiner has offered no evidence as to why such would not be the case.

Considering the Examiner's comments in turn:

1. The Examiner contends that undue experimentation would be required to practice the invention because of the "large proportion of inoperative pathogens or inhibitors claimed." Conspicuous by its absence is any detail as to the specific nature of such allegedly inoperative embodiments. The Examiner is requested to provide such details so that Applicants will be in a position to respond.
2. The Examiner contends that there is insufficient direction/guidance to predict which pathogens/inhibitors encompassed by the claims would work. The Examiner offers nothing by way of explanation as to what further direction/guidance would be required.
3. The Examiner contends that Applicants do not teach or suggest the use of the claimed method for pathogens/inhibitors beyond those specifically taught. The Examiner's comment overlooks the disclosure at, for example, page 14, line 8 to page 15, line 24.
4. The Examiner's comments regarding the complexity/unpredictability of the invention are unsupported.
5. The Examiner is requested to identify the prior art to which he refers so that Applicants will be positioned to respond.
6. The Examiner's comment regarding the unpredictability of the art is unsupported.
7. The fact that the claims encompass a number of pathogens and inhibitors does not negate the fact that the claims are enabled.
8. The Examiner's apparent assertion to the contrary, the ordinary skill level in the relevant art is high.

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The Examiner is respectfully requested to reconsider his position. It is believed that, having done so, he will find withdrawal of the rejection to be in order.

This application is submitted to be in condition for allowance and a Notice to that effect is requested.

Respectfully submitted,

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